

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 7, 9, 13, 15, 20, 22 and 26 contain allowable subject matter and would be allowable if rewritten in independent form including the features of their base claim and intervening claims. In response, claims 7, 9, 13, 15, 20, 22 and 26 have been rewritten in independent form including the features of their base claim and intervening claims. Claims 7, 9, 20 and 22 have been rewritten to address the rejections under 35 U.S.C. § 112, second paragraph as discussed below. Applicants respectfully submit that claims 7, 9, 13, 15, 20, 22 and 26 are allowable.

In the Official Action, the Examiner rejects claims 1-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the Examiner argues that since the moving mechanism is a parallelogram and has four sides, the first and second sides cannot be determined. Applicants submit that the Examiner is reading limitations into the claim that do not appear therein. Although, the specification discloses an embodiment in which the moving mechanism is a parallelogram, the claim does not recite such a configuration. The Applicants are entitled to recite a claim having a scope as broad as the prior art will allow. Thus, Applicants submit it is not necessary that claim 1 recite the four sides of a parallelogram. However, claim 1 has been amended to clarify that the moving mechanism has at least first and second sides. Support for the amendment to claim 1 can be found throughout the original disclosure, for example at reference numerals 16a and 16d of Figure 1.

Further with regard to claim 1, the Examiner argues that it is unclear how the supporting mechanism can rotate about the shaft and indicates that the axis intended is axis 02, which is perpendicular to the shaft. In response, claim 1 has been further amended to clarify that the shaft portion is operatively connected along a longitudinal length of the first side such that the medical instrument and supporting mechanism can be rotated about the shaft portion. Support for the further amendment to claim 1 can be found throughout the original disclosure, for example at reference numerals 16a, 27, 55 and 14 of Figure 1.

Still further with regard to claim 1, the Examiner argues that the same is indefinite because the structure is dependent upon a center of gravity that is variable depending upon the medical instrument and an orientation of the holding member. Again, the Examiner is reading limitations into the claims that do not appear therein. Claim 1 does not indicate that a center of gravity depends upon a medical instrument or a holding member. Claim 1 recites the position of the ball joint with reference to a center of gravity of the holding portion, namely, that the ball joint is positioned shifted from a center of gravity of the holding portion towards the moving mechanism.

Claim 1 has been further amended to clarify that the distal end portion of the supporting mechanism is adapted to support a medical instrument and the holding portion is adapted for being held by the operator. Lastly, claim 1 has been amended to clarify that the ball joint couples the moving mechanism to the supporting mechanism via the second side of the moving mechanism as is supported in the original disclosure, e.g., at reference numeral 16d of Figure 1.

The Examiner argues that claims 3, 16, 28 and 31 are indefinite because there is no antecedent basis for the term "the center of inclination" appearing therein. In response, claims 3, 16, 28 and 31 have been amended to change the same to --a center of inclination--.

The Examiner argues that claim 27 is indefinite because there is no antecedent basis for the term "the moving mechanism" appearing therein. In response, claims 3, 16, 28 and 31 have been amended to change the same to --a center of inclination--.

Further with regard to claims 3, 16, 28 and 31, the Examiner argues that the same are indefinite because they are dependent upon an arbitrary medical instrument that will determine the center of gravity and center of operation and the way that the operator grasps the device. In response, claims 3, 16, 28 and 31 have been amended clarify the same and to positively recite the medical instrument as part of the device.

Further with regard to claim 27, the Examiner argues that the same is indefinite because it is not clear how the elements are operatively connected, as the term "located" does not necessarily include a connection or coupling. Although Applicants respectfully submit that the term "located" is interpreted as defined in the specification and to those of ordinary skill in the art, claim 27 has been amended to clarify the connections between elements.

In the Official Action, the Examiner rejects claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0027313 to Shimmura et al., (hereinafter "Shimmura"). Furthermore, the Examiner rejects claims 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Shimmura.

In response, independent claims 1, 17 and 30 have been amended to clarify their distinguishing features.

Specifically, independent claim has been amended to recite that the ball joint further supports the supporting mechanism from below the supporting mechanism in the direction of gravity to be pivotable with respect to the moving mechanism. Claims 27 and 30 have been similarly amended. Applicants respectfully submit that although the term "below" may at times be found to be indefinite, the same has been defined in the claims as being "in the direction of gravity." The amendment to the claims is fully supported in the original disclosure, particularly in the Drawings at Figures 1 and 3-5 and the accompanying description of the specification. Thus, no new matter has been entered into the disclosure by way of the amendment to the claims. Applicants respectfully submit that the holding apparatus of Shimmura simply does not disclose or suggest such a feature.

With regard to the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-32 under 35 U.S.C. § 102(b), a medical instrument holding apparatus having the features discussed above and as recited in independent claims 1, 27 and 30, is nowhere disclosed in Shimmura. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1, 27 and 30 are not anticipated by Shimmura. Accordingly, independent claims 1, 27 and 30 patentably distinguish over Shimmura and are allowable. Claims 2-6, 8, 10-12, 14, 16-19, 21, 23-35, 28, 29, 31 and 32 being dependent upon claims 1, 27 and 30, are thus at least allowable therewith.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejection of claims 33 and 34 under 35 U.S.C. § 103(a), since independent claim 30 patentably distinguishes over the prior art and is allowable, claims 33 and 34 are at least allowable therewith because they depend from an allowable base claim.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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